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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

05725.0978-00000

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on _____

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name _____

Application Number

10/024,495

Filed

December 21, 2001

First Named Inventor

Gilles RUBINSTENN

Art Unit

2625

Examiner

Manav Seth

Applicants request review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a Notice of Appeal.

The review is requested for the reasons stated on the attached sheets.

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

Signature

☐

assignee of record of the entire interest.

See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.

Ronald J. Ward

Typed or printed name

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attorney or agent of record

Registration number _____

571.203.2723

Telephone number

☒

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 **54,870**

April 3, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.

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*Total of 1 form is submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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PATENT
Customer No.: 22,852
Attorney Docket No. 05725.0978-00

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:)
)
Gilles RUBINSTENN et al.) Group Art Unit: 2625
)
Application No.: 10/024,495) Examiner: Manav Seth
)
Filed: December 21, 2001) Confirmation No.: 4461
)
For: FEATURE EXTRACTION IN)
BEAUTY ANALYSIS)

Mail Stop AF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

In conjunction with a Notice of Appeal under 37 C.F.R. § 41.31, completed form PTO/SB/33, petition for a one-month extension of time, appeal fee payment, and extension of time fee payment filed concurrently herewith, Applicants respectfully request a pre-appeal brief review of this application.

I. Status of Claims

Claims 1-8 and 10-37 remain pending in this application. Claims 1-8, 10-23, 26-28, and 31-37 stand rejected under 35 U.S.C. § 103(a) based on U.S. Patent No. 6,571,003 ("*Hillebrand*") and U.S. Patent No. 6,208,749 ("*Krusin*"); claims 24 and 29 stand rejected under 35 U.S.C. § 103(a) based on *Hillebrand*, *Krusin*, and U.S. Patent No. 3,030,967 ("*Peyron*"); and claims 25 and 30 stand rejected under 35 U.S.C. § 103(a) based on *Hillebrand*, *Krusin*, and "Ultraviolet Radiation," EHC Journal, 1994 ("*EHC Journal*").

II. Rejection of Claims 1-8, 10-23, 26-28, and 31-37 Under 35 U.S.C. § 103(a)

Applicants respectfully submit that the Examiner failed to establish a *prima facie* case of obviousness in rejecting claims 1-8, 10-23, 26-28, and 31-37 under 35 U.S.C.

§ 103(a) as being unpatentable based on *Hillebrand* and *Krusin* for at least the reason that the references, taken alone or in combination, do not teach or suggest each and every element recited in the claims. See M.P.E.P. § 2143. Moreover, there would have been no suggestion or motivation to one of ordinary skill in the art at the time the invention was made to modify *Hillebrand* in view of *Krusin*. See M.P.E.P. § 706.02.(j)

For example, independent claim 1 recites a method comprising, among other things, “displaying [a] skin condition image such that [a] subject is substantially unidentifiable.” *Hillebrand* and *Krusin* fail to teach or suggest at least this element of claim 1. On page 4 of the final Office Action, the Examiner alleged that “if an image of just a skin (or sub-image) of the subject is taken and displayed as disclosed by *Hillebrand*, the subject would be unquestionably unidentifiable.” However, *Hillebrand* discloses identifying defects on a subject’s identifiable facial image and displaying the defects on the identifiable facial image (Figs. 5 and 11-14; col. 5, lines 27-28; col. 11, lines 4-13). Thus, *Hillebrand* discloses the exact opposite of displaying a skin condition image such that the subject is substantially unidentifiable, as recited in claim 1.

The Examiner asserted that well-known image processing operations remove image portions from images and cited *Krusin* for support. Final Office Action, pp. 4 and 5. Based on these assertions, the Examiner alleged that it would have been obvious to modify *Hillebrand* to display an image of a subject’s skin in a way that made the subject unquestionably unidentifiable because it will “keep the secrecy of the subject.” *Id.* This conclusion, however, is not properly supported by evidence in the record. Neither *Hillebrand* nor *Krusin* mentions anything about keeping the secrecy of the subject. Indeed, as discussed above, *Hillebrand* expressly discloses displaying a subject’s identifiable face, which teaches away from keeping the secrecy of the subject. Accordingly, the conclusions in the final Office Action were not reached based on facts from the prior art, but instead the teachings of the present application were improperly used in hindsight to reconstruct the prior art.

The final Office Action also fails to set forth a *prima facie* case of obviousness for claims 34-37. On page 10 of the final Office Action, the Examiner alleged that *Hillebrand* discloses the analysis of hair (claim 34) or nails (claim 36). Specifically, the Examiner attempted to equate analysis of spots on skin with analysis of hair or nails.

See final Office Action, page 10. However, the analysis of spots on skin is not the same as, and does not suggest, analysis of hair or nails, and there is no suggestion in the cited art indicating otherwise. For example, as described in *Hillebrand*, analysis of spots is the analysis of inflamed red spots such as acne, or hyperpigmented spots such as senile lentigines (i.e., small flat pigmented spots), nevi (i.e., moles), and freckles (col. 8, lines 6-10). Moreover, an interpretation that equates hair and nails with spots on skin is neither supported by the specification nor consistent with the interpretation that those skilled in the art would reach. See M.P.E.P. § 2111.

Because *Hillebrand* and *Krusin* fail to teach or suggest each and every element of claims 1, 34, and 36, and because there would have been no motivation to combine the features of *Hillebrand* and *Krusin*, the final Office Action fails to establish a *prima facie* case of obviousness.¹ Independent claims 22, 27, 32, and 33, although of different scope, recite elements similar to those of claim 1 discussed above and, therefore, the Section 103(c) rejection of those claims is also improper.

III. Rejection of Claims 24 and 29 Under 35 U.S.C. § 103(a)

Applicants respectfully submit that the Examiner failed to establish a *prima facie* case of obviousness in rejecting claims 24 and 29 based on *Hillebrand*, *Krusin*, and *Peyron* for at least the reason that there is no suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify or combine the references in the manner proposed by the Examiner.

Independent claim 24 recites a method of performing a skin analysis comprising various elements, “wherein skin in [a] received image is covered with powder to facilitate extracting . . . at least one representation.” Claim 29, although of different scope, includes a similar recitation.

On page 11 of the final Office Action, the Examiner properly observed that *Hillebrand* and *Krusin* fail to teach or suggest this element. The Examiner sought to cure the deficiency of *Hillebrand* and *Krusin* by relying on *Peyron* for the purported

¹ Moreover, dependent claims 2-8, 10-21, 23, 26, 28, 31, 35, and 37 are also allowable at least by virtue of the dependence of those claims upon one of allowable claims 1, 27, 34, and 36.

disclosure of using powder on skin to emphasize skin defects. See final Office Action, page 11 (citing *Peyron*, col. 1, lines 37-42). The Examiner alleged that it would have been obvious to modify the combination of *Hillebrand* and *Krusin* with *Peyron* because it “would help in obtaining better image skin analysis results.” *Id.* However, *Peyron* does not suggest the desirability of using powder in obtaining better image skin analysis results. Instead, *Peyron* discloses a process for applying cosmetic material to the skin to hide defects (col. 1, lines 55-64) and that accentuating skin defects with make-up products was a problem (col. 1, lines 29-37). Accordingly, the Examiner has failed to set forth a *prima facie* case of obviousness, and is instead using the teachings of the present application in hindsight to reconstruct the prior art.

Accordingly, for at least the above reasons, the rejection of independent claims 24 and 29 under 35 U.S.C. § 103(a) should be withdrawn.

IV. Rejection of Claims 25 and 30 Under 35 U.S.C. § 103(a)

Applicants respectfully submit that the Examiner failed to establish a *prima facie* case of obviousness in rejecting claims 25 and 30 based on *Hillebrand*, *Krusin*, and *EHC Journal* for at least the reason that the references, taken alone or in combination, do not teach or suggest each and every element recited in the claims.

For example, claim 25 recites a method of performing a skin analysis comprising, among other things, “extracting from . . . at least one [received] image at least one representation of . . . at least one skin condition . . . , wherein skin in the received image is illuminated with a Woods lamp to facilitate extracting the at least one representation.” Claim 30, although of different scope, includes a similar recitation.

On pages 11 and 12 of the final Office Action, the Examiner properly observed that *Hillebrand* and *Krusin* fail to teach or suggest this element. The Examiner sought to cure the deficiency of *Hillebrand* and *Krusin* by relying on *EHC Journal*. According to the Examiner, *EHC Journal* purportedly teaches using a Woods lamp in skin analysis. See final Office Action, page 12 (citing *EHC Journal*, page 45). However, *EHC Journal* makes no mention of, and does not suggest, using a Woods lamp to facilitate extracting of a representation of a skin condition from a received image, as recited in claims 25 and 30. *EHC Journal* merely discloses using a Woods lamp to identify the presence of

fungus and bacterial infectious agents on skin or in wounds. Hence, the Examiner has not shown that the prior art suggests the desirability of using a Woods lamp to facilitate extracting a representation of a skin condition from a received image. Accordingly, the Examiner has failed to set forth a *prima facie* case of obviousness, and is instead using the teachings of the present application in hindsight to reconstruct the prior art.

Accordingly, for at least the above reasons, the rejection of independent claims 25 and 30 under 35 U.S.C. § 103(a) should be withdrawn.

V. Conclusion

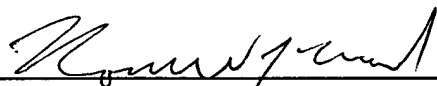
Because the Examiner's 35 U.S.C. § 103(a) rejections of the claims are based on factual deficiencies and include errors, as demonstrated herein, Applicant is entitled to a pre-appeal brief review of the final Office Action. Moreover, all of the claim rejections should be withdrawn.

Please grant any extensions of time required to enter this Request and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: April 3, 2006

By: 
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